UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MARC BIRKNER, JEAN LUC GIRAUD, and
LAURENT TALVARD

_____

Appeal 2008-005962
Application 09/831,745
Technology Center 2400

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Decided: September 24, 2009

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Before JAMES D. THOMAS, JEAN R. HOMERE, and JAY P. LUCAS,
Administrative Patent Judges.

THOMAS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final
rejection of claims 1, 3-8, 10-13, 15-23, and 36-38. Appellants have
cancelled claims 2 and 14. The Examiner has allowed claims 24-35 and has

objected to claim 9. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Invention

The invention concerns a device and a method for controlling a portable object life cycle, in particular a smart card, the life cycle being determined by successive state transitions, which states determine the services offered by the object. The object includes a processing unit, program storage units and data storage units, each storage unit having a content defining a plurality of configurations. The device controls the transition from a first state to a second state of the object and, preferably triggers actions when the transition crossover from one state to another occurs or when a transition crossover request is denied. The actions are dependent on the type of transitions implied in the requests for state transition crossover applied to the object.

(Abstract; *See* Figs. 1, 5, and 6)

Illustrative Claims 1 and 12

1.   A device for controlling the life cycle of a portable electronic object, the life cycle being determined by succession of state transitions, said states determining the services offered by the object, said object comprising a processing unit, a volatile memory, program memories and data memories, each of said memories having a content defining a plurality of configurations, wherein said device comprises means for controlling the transition from a first state to a second state of the portable electronic object, including means for selectively enabling and/or inhibiting state transitions, and means for checking the content of the volatile memory, the data memories and the program memories of the portable electronic object as a function of the state transition to be effected, so that only some

transitions are permitted amongst all the transitions between any two possible states of the portable electronic object.

12.   A method of controlling the life cycle of a portable electronic object, the life cycle being determined by a succession of state transitions, said states determining the services offered by the object, said object comprising a processing unit, a volatile memory, program memories and data memories, each of said memories having a content defining a plurality of configurations, said method being implemented, within the object, following a request _to transition from a current state to a new state, according to the following steps:

- a step of validation of the enabling of said request using means for enabling and/or inhibiting state transitions, so that only certain transitions are permitted amongst all the transitions between any two possible states of the object;

- a step of evaluating checks on the configuration of the object that are associated with a permitted transition; and

- a step of changing to the new state of the object if the requested transition is enabled and if said checks on the configuration of the object are satisfied.

Prior Art and Examiner's Rejections

The Examiner relies on the following references as evidence of anticipation and unpatentability:

Chan	US 6,005,942	Dec. 21, 1999
		(Mar. 24, 1998)
Grimonprez	US 5,473,690	Dec. 05, 1995
Wagner	US 5,301,100	Apr. 05, 1994

Silberschatz, Database System Concepts, 3rd Edition, McGraw-Hill
Company, Inc. (1998), pgs. 23-110.

Claims 1, 7, 10-17, and 36 stand rejected under 35 U.S.C. § 102(e) as

being anticipated by Chan. All other claims on appeal stand rejected under

35 U.S.C. § 103. As evidence of obviousness as to claims 3 and 18, the

Examiner relies upon Chan and Wagner. This combination of references is

utilized along with Silberschatz to reject claims 4-6, 8, and 19-23. Lastly, the

Examiner relies upon Chan in view of Grimonprez as to claims 37 and 38.

Claim Groupings

In accordance with Appellants' arguments in the principal Brief on

appeal and because commonly argued subject matter appears in each of

them, we consider independent claim 1 as representative of the subject

matter of independent claims 1, 10, and 11. Separate arguments are

presented as to independent claim 12.

ISSUES

1)   Have Appellants shown that the Examiner erred in finding that Chan

teaches the claimed "means for checking the content of the volatile memory,

the data memories and the program memories of the portable electronic

object as a function of the state transition to be effected" in representative

independent claim 1 on appeal?

2)   Have Appellants shown that the Examiner erred in finding that Chan

teaches the feature of independent claim 12 of "a step of evaluating checks

on the configuration of the object that are associated with a permitted

transition?"

FINDINGS OF FACT

1) As to the subject matter of representative independent claim 1 on

appeal, Appellants argue at page 2 of the Reply Brief:

> Chan, at most, discloses that the contents of the
> EEPROM are relevant to card life cycle and applet life cycle.
> Chan, however, does not disclose that the contents of the ROM,
> the EEPROM, and the RAM are checked as a function of a state
> transition to be effected. For example, Chan discloses that the
> card life cycle is managed by a card domain application 308,
> and that the card domain application 308 keeps track of what
> state the card is in during its life cycle. Col. 6, lines 31-36.
> However, Chan does not disclose how the card domain
> application 308 keeps track of the state of the card life cycle.
> Further, Chan does not suggest that a checking of memory
> content is performed as a state transition is to be effected.
> Therefore, the Examiner's contention that the card life cycle in
> Chan is determined by the contents of the ROM, EEPROM and
> RAM is unsupported by the disclosure of Chan. As such, the
> reference cannot be interpreted to disclose that the content of all
> three types of memory is checked as a function of a state
> transition to be effected.

2) As to independent claim 12, Appellants take these positions at page 3

of the Reply Brief as reflected in the following:

> Chan does not disclose how a current state of the card is
> checked. Chan, however, discloses that the card domain
> application 308 keeps track of the state of the card life cycle.
> One of ordinary skill of the art would understand that the
> current state of the card is probably a parameter stored in a

dedicated location, and read by the card domain application
308. Chan does not provide any suggestion that the indication
of the current state of the card is stored in all memories.

In contrast, claim 12 describes evaluating checks on the
configuration of the object that are associated with a permitted

transition. Such checks on the configuration of the object
guarantee a coherent memory configuration for the object at the
time of a transition request. *See* Specification, the paragraph
bridging pages 21-22. Appellants respectfully submit that
checking a parameter in a dedicated location, as suggested in
Chan, cannot be considered as checking the configuration of the
object, as described in claim 12. Therefore, checking the current
state of the card does not correspond to checking the
configuration of the card.

PRINCIPLES OF LAW

Anticipation

"A claim is anticipated only if each and every element as set forth in
the claim is found, either expressly or inherently described, in a single prior
art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d
628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over
the prior art under 35 U.S.C. § 102 begins with a determination of the scope
of the claim. We determine the scope of the claims in patent applications
not solely on the basis of the claim language, but upon giving claims their
broadest reasonable construction in light of the specification as it would be
interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech.
Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim
must then be compared with the prior art.

ANALYSIS

Issue statement 1 in this opinion reflects the common arguments of Appellants at page 8 of the Brief and the initial paragraph at page 1 of the Reply Brief. In response to the initial position in the Brief, the Examiner further relies upon the teaching of column 13 of Chan relating to the introduction of the topic of the life cycle of a smart card. Reference is made there to include certain types of memories.

With respect to this refined reliance of the Examiner upon the teachings of Chan, we conclude we must agree with Appellants' general assertions in the position set forth in FF1 earlier in this opinion. In essence, the Examiner has not persuaded us that the person of ordinary skill in the art would have concluded that, notwithstanding the mention of various types of memories recited in the argued feature in representative independent claim 1 on appeal, there is no apparent teaching of checking the content of the respective memories as a function of the state transition to be effected, as recited in this claim.

Turning next to the subject matter of issue statement number 2 reflecting the argued feature of independent claim 12 on appeal, we also agree with Appellants' views expressed at page 3 of the Reply Brief that we enclosed within FF 2. The Examiner's responsive arguments in the Answer made mention of teachings of column 14 and refer to those at column 12 that make general reference to the life cycle depiction of a card in Figure 7A. The discussion at column 14 relates to Figure 9 and the ability of a given application to detect a problem which yields a card block request. Although conceptually this relates to the concept of evaluating checks of the configuration of the smart card itself, there is no more specific teaching

corresponding to the requirement that the evaluation checks must be associated with a permitted transition, as claimed.

Generally, the level of specificity required by the argued subject matter of representative independent claim 1 on appeal as well as that of independent claim 12 does not appear to be met by the relied upon teachings of Chan. Chan's teachings do not appear to reach the level of discrete state transitions. Therefore, inescapably, we must agree with the positions set forth best by Appellants in noted portions of the Reply Brief.

CONCLUSIONS AND DECISION

Appellants have shown that the Examiner erred in finding that Chan teaches the argued feature of issue statement 1 that reflects the argued subject matter in the first issue statement of representative independent claim 1 on appeal. Correspondingly, Appellants have shown the Examiner erred in finding that Chan teaches the argued features of independent claim 12 reflected in the second issue statement earlier in this opinion. Since the Examiner erred as to the subject matter of independent claims 1, 10, 11, and 12 on appeal being fully met by the teachings in Chan, we correspondingly reverse the three separately stated rejections of the remaining claims on appeal on 35 U.S.C. § 103. Therefore, the decision of the Examiner rejecting all claims on appeal is reversed.

REVERSED

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